

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ZO YOUNGER

Appeal No. 1996-0743
Application 08/152,741

ON BRIEF

Before CALVERT, ABRAMS and STAAB, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 5, 7, 9, 15-30. Claims 37-42 and 46, the only other claims remaining in the application, have been withdrawn from further consideration under 37 CFR § 1.142(b) as not being readable on the elected invention.

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Appellant's invention pertains to a self mailer formed from a single cut sheet and including a return envelope. A copy of the appealed claims appears in an appendix to appellant's brief.¹

The prior art references of record relied upon by the examiner as evidence of obviousness are:

Stewart et al. (Stewart)	4,715,531	Dec. 29, 1987
Sauerwine et al. (Sauerwine)	5,289,972	Mar. 1, 1994

Claims 7, 9, 15-18 and 20-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stewart.

Claims 5, 19 and 24-30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stewart in view of Sauerwine.

The rejections are explained in the initial office action (Paper No. 3, mailed June 29, 1994) and the examiner's answer

¹ In the copy of claim 15 appearing in the appendix to the brief, at line 11, --, said second tear strip having adhesive applied thereto-- should appear after "said second side", and at lines 23-24, "said adhesive on said first and second thin strips of adhesive and" should be deleted. In the copy of claim 24 appearing in the appendix to the brief, at line 11, --, said second tear strip having adhesive applied thereto-- should appear after "said second side".

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(Paper No. 10, mailed October 11, 1995).

The opposing viewpoints of appellant are set forth in the brief (Paper No. 8, filed August 16, 1995).

Claims 7 and 9

Independent claim 7 calls for the size of the single sheet business form to be about 8.5" wide by about 11" long, with the distance between the top of the form and the first transverse line of weakening **44**² being about 3.5" and the distance between the lower edge **72** of the lateral strip of adhesive **48** and the bottom of the form being about 7".

Independent claim 9 calls for the size of the single sheet business form to be about 8.5" wide by about 14" long, with the distance between the top of the form and the first transverse line of weakening **44** being about 4 and 7/8" and the distance between the lower edge **72** of the lateral strip of adhesive **48** and the bottom of the form being about 8".

² Throughout this decision, bold format numbers denote reference numerals appearing in appellant's drawing figures.

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The examiner recognizes that Stewart is silent as to the overall dimensions of the sheet and the placement of the various fold lines and strips of adhesive relative to the sheet's edges. However, the examiner considers that

[t]he exact specific dimensions of the business form to be a letter or a legal sized sheet of paper and the placement of the transverse line of weakening and the lateral strip would have been an obvious matter of design choice . . . since applicant has not disclosed

that the position of the transverse line of weakening and lateral strip and size of the business form solves any stated problem and it appears that the invention would perform equally well with the business form as shown in Stewart et al. [First office action, page 5.]

Regardless of how we attempt to read claims 7 and 9 on the envelope of Stewart, we cannot agree with the examiner's position to the effect that it would have been obvious to reconfigure Stewart's reusable envelope in the manner that would correspond to the subject matter of claims 7 and 9. Considering first claim 7, Stewart's envelope comprises only two laterally extending strips of adhesive, namely, strip of adhesive 47 on the side of the sheet that will become the inside of the first mailed envelope (see Figure 1), and strip

of adhesive 57 on the side of the sheet that will become the inside of the second return envelope (see Figures 2 and 6). If, on the one hand, we attempt to read the claimed lateral strip of adhesive on Stewart's strip 47, the top of the sheet and the bottom of the sheet must be as viewed in Figure 1 because claim 7 requires that the lateral strip of adhesive be located between the transverse line of weakening and the bottom of the sheet. Under these circumstances, it certainly would not have been obvious to one of

ordinary skill in the art to relocate strip 47 of Stewart so that its lower edge is about 7" from the bottom of the sheet, as called for in claim 7, because to do so would result in a tear strip that would be excessively large, resulting in needless waste of material. If, on the other hand, we attempt to read the claimed lateral strip of adhesive on Stewart's strip 57, and further consider the top of the sheet to be as shown in Figure 2, relocating the strip so that its lower edge is about 7" from the bottom of the sheet would again result in the same excessively large tear strip and needless waste of

material. Additionally, if Figure 2 of Stewart were to be turned upside down (i.e., if the lower edge of the sheet as viewed in Figure 2 were to be considered the top of the sheet), such that line 38 of Stewart was considered to be the first transverse line of weakening, it still would not have been obvious to relocate the lower edge of the strip of adhesive 57 about 7" from the bottom of the sheet because to do so would greatly diminish, if not completely destroy, the ability of strip 57 to act as a closure for a return envelope derived from an originally sized 8.5" by 11" sheet. The examiner's position as applied to claim 9 is without merit for similar reasons.

In view of the fact that the examiner's proposed modification of Stewart would render it unsuitable for its intended purpose, it cannot be said that it would have been obvious to one of ordinary skill in the art. *Ex parte Rosenfeld*, 130 USPQ 113, 115 (Bd. App. 1961). It follows that the standing § 103 rejection of claims 7 and 9 as being

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unpatentable over Stewart cannot be sustained.

Claims 15-18 and 20-23

The last paragraph of independent claim 15 calls for the base sheet to be folded along a base fold line **78** and secured by the first and second thin strips of adhesive **70**, **74** and the adhesive **64** on the first and second tear strips **32**, **38** to define an envelope. The examiner has not explained, and it is not apparent to us, where Stewart teaches an envelope formed by folding the sheet along a base fold line and securing it by first and second sets of adhesive strips to define an envelope, as now claimed. In this regard, Stewart's first set of adhesive strips 43, 45 act alone to form the first envelope and Stewart's second set of adhesive strips 53, 55 act alone to form the second return envelope.

For this reason, the standing § 103 rejection of independent claim 15 as being unpatentable over Stewart, as well as claims 16-18 and 20-23 that depend therefrom, cannot be sustained.

Claim 5

Concerning the examiner's § 103 rejection of claim 5 as being unpatentable over Stewart in view of Sauerwine, the only argued distinction of claim 5 over Stewart is the requirement of claim 5 that the adhesive of the lateral strip of adhesive 48 is remoistenable glue. While conceding that remoistenable glue "is, of course, the same sort of glue encountered on the flaps of conventional business envelopes" (brief, page 7), appellant contends that one of ordinary skill in the art would never consider using remoistenable glue at adhesive strip 57 on return flap 28 of Stewart because

[t]he remoistenable glue would be exposed on the exterior of the envelope at all times during the mailing process. If it got wet, it might cause the envelope to adhere to other pieces of mail. Alternatively, it might pick-up all manner of debris, bacteria or the like and certainly would not be suitable for licking with the tongue. Indeed, it's hard to imagine a situation where the substitution proposed by the examiner is so unlikely. [Brief, pages 7-8.]

This argument is not well taken. Claim 5 does not require that the lateral strip of adhesive set forth in the last paragraph of the claim be for the return envelope flap. Thus, even if we were to agree with appellant that, as a

general proposition, it would not have been obvious to provide remoistenable glue at adhesive strip 57 on Stewart's return envelope flap, there remains the question of providing remoistenable glue at Stewart's adhesive strip 47, used on the closure flap of the first mailed envelope. Stewart describes this adhesive strip as being "an activatable adhesive for example a *wetable* adhesive or a two-part adhesive or a two-sided tape with a release strip 46 as shown" (column 3, lines 13-15; emphasis added). To the extent "wetable" adhesive is not "remoistenable" adhesive as claimed, it would have been obvious to one of ordinary skill in the art to use a conventional remoistenable glue at Stewart's adhesive strip 47 in view of Sauerwine's teaching at column 4, lines 22-26, that adhesive 40 for envelope flap 39 may be "any type of adhesive that can be activated by the end user to form a sealed return envelope, such as *rewettable* adhesive, or pressure sensitive adhesive covered by a release liner strip" (emphasis added). In this regard, the circumstance that Sauerwine's adhesive 40 is used to close the flap of Sauerwine's return envelope is not seen as limiting that teaching to the closure flaps of

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return envelopes.

In light of the foregoing, we will sustain the standing § 103 rejection of claim 5 as being unpatentable over Stewart in view of Sauerwine.

Claims 19 and 24-30

Independent claim 24 is similar to claim 15 in the sense that it also calls for the base sheet to be folded along a base fold line **78** and secured by the first and second thin strips of adhesive **70**, **74** and by the adhesive **64** on the first and second tear strips **32**, **38** to define an envelope. Claim 19 depends from independent claim 15 and thus includes this limitation through its dependency therefrom. We have thoroughly reviewed the teachings of Sauerwine additionally relied upon by the examiner in rejecting claims 19 and 24, but find nothing therein that makes up for the above noted deficiencies of Stewart with respect to this limitation. Accordingly, we cannot sustain the examiner's rejection of claims 19 and 24, or claims 25-30 which depend from claim 24, based on the combined teachings of Stewart and Sauerwine.

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Summary

The standing § 103 rejections of claims 7, 9 and 15-30
are reversed.

The standing § 103 rejection of claim 5 is affirmed.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

	IAN A. CALVERT)	
	Administrative Patent Judge)	
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	NEAL E. ABRAMS)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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